



SERIAL NO. 10/820,893


PATENT APPLICATION

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

| | | | |
|-------------|---------------|-----------------|------------|
| Applicant: | ROUSU et al. | Examiner: | Ewart, J. |
| Serial No.: | 10/820,893 | Group Art Unit: | 2617 |
| Filed: | April 8, 2004 | Docket No.: | NKO.034.A1 |

Title: TRANSMISSION OF LOCATION RELATED INFORMATION

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this communication is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 13, 2008.

By: 
Rennae Johnson

NOTICE OF APPEAL UNDER 37 C.F.R. § 41.31

AND

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant submits herewith a Notice of Appeal and a Pre-Appeal Brief Request for Review. No amendments are being filed with this communication.

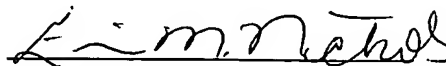
Enclosed with this request, Applicant is submitting herewith the following:

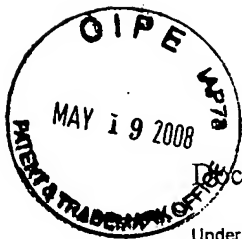
- ☒ Notice of Appeal
- ☒ Pre-Appeal Brief Request for Review (PTO/SB/33)
- ☒ Statement regarding Pre-Appeal Brief Request for Review (4 pages)
- ☒ Petition for Extension of Time
- ☒ 1 Return Postcard

Authorization is given to charge/credit Deposit Account No. 50-3581 (NKO.034.A1) for any deficiencies/overpayments associated with this filing.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
Attorneys at Law
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Minneapolis, MN 55425
952.854.2700 (tel.)

By: 
Erin M. Nichols
Reg. No.: 57,125



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NKO.034.A1

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May 13, 2008

on

Signature

Typed or printed name

Rennae Johnson

Application Number

10/820,893

Filed

April 8, 2004

First Named Inventor

Rousu et al.

Art Unit

2617

Examiner

Ewart, J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

57,125

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Erin M. Nichols

Typed or printed name

952-854-2700

Telephone number

May 13, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

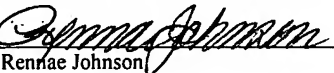
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Appellant: Rousu et al. Examiner: Ewart, J.
Serial No.: 10/820,893 Group Art Unit: 2617
Filed: April 8, 2004 Docket No.: NKO.034.A1
Title: TRANSMISSION OF LOCATION RELATED INFORMATION

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 13, 2008.

By 
Rennae Johnson

**APPELLANT'S STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005 on New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are clearly not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejection, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal brief review is appropriate.

Each of the pending independent claims is rejected under § 103(a) over a primary combination of the teachings of U.S. Patent No. 6,867,733 to Sandhu *et al.* (hereinafter "Sandhu") in view of U.S. Patent No. 5,602,665 to Asako (hereinafter "Asako").

While Appellant has multiple issues for appeal, the primary purpose for submitting this particular request for review concerns omissions of essential elements required for a *prima facie* § 103(a) rejection. Although each of the independent claims is rejected in the final Office Action (dated December 28, 2007) primarily in view of Sandhu and Asako, Asako does not teach the

claim limitations as asserted and does not overcome the admitted deficiencies in the teachings of Sandhu.

Sandhu admittedly does not teach or suggest that in response to the transmitting of speech and/or data by a mobile device, information about the location of the mobile device is transmitted with the speech or data to a predefined group of users currently connected to a network element of the communication system, as claimed in each of the independent claims. Instead, the Examiner contends that Asako teaches that when a communication device transmits data, the device detects the transmission and responds to the transmission. However, this contention is incorrect as Asako merely teaches converting input data to an output transmission of light. For example, Asako teaches that:

Transmission data input from one side of a terminal is converted into current signals for driving the semiconductor laser in the laser driving circuit. The semiconductor laser functions as an electric/optical converting element and outputs light signals having a level that is set in response to the current signals. These light signals pass through the optical directional coupler and are then output to the optical fiber. Column 1, lines 29-35.

In contrast to the Examiner's assertion, there is no detection of transmission and response, but rather, Asako teaches conversion of the data to be transmitted. This is clearly shown in the cited portion of Asako at column 6, "the light emitted from the semiconductor laser 11 is intensity-modulated in correspondence with the content of the transmission data". Asako is directed to an optical transmitting apparatus (*see* Title) and merely teaches entering data to be transmitted and converting such data into light signals in order to effect the transmission. There is no detection of transmission and then a response as asserted by the Examiner. Thus, the cited teachings of Asako do not teach that which is asserted and further fail to correspond to the claim limitations absent from Sandhu.

The asserted teachings of Asako fail to overcome the admitted deficiencies in the teachings of Sandhu. Sandhu fails to teach transmitting, with speech and/or data, information about the location of a mobile device in response to the transmitting of speech or data, as claimed. Instead, Sandhu teaches at column two that location data is encapsulated and initially transmitted in an outbound package to a service provider such

that location data is not transmitted in response to prior transmission of speech/data by the same device. Also, there is no suggestion that Asako teaches detecting a transmission and then transmitting additional information with the detected transmission, as claimed. Thus, neither Sandhu nor Asako teaches at least these limitations. As neither Sandhu nor Asako teaches these limitations, any combination thereof must also fail to teach such limitations.

Although Asako is solely relied upon as teaching these limitations, none of the other cited references have been asserted, or shown, to teach the above-discussed limitations directed to transmitting, with the speech or data, information about the location of the mobile device (in response to the transmitting of speech and/or data by the mobile device). Therefore, the further reliance on each of the additionally cited references does not overcome the deficiencies in the teachings of Sandhu and Asako. Thus, each of the asserted combinations of references fails to teach or suggest at least these limitations, rendering each of the § 103(a) rejections unsupported and improper.

Thus, it is respectfully submitted that there is an omission of an essential element needed for a *prima facie* obviousness rejection. Sandhu does not teach or suggest at least transmitting, with speech or data, information about the location of a mobile device in response to the transmitting of speech and/or data by the mobile device. Although Asako is solely relied upon as teaching these claimed features, Asako also fails to correspond to these limitations. Because Asako does not involve or otherwise address transmitting, with speech or data, information about the location of a mobile device in response to the transmitting of speech and/or data by the mobile device, Appellant believes these claim limitations are improperly being overlooked, and consequently there is an omission of an essential element(s) required for a *prima facie* rejection.

It is Appellant's position that the Examiner's reliance on Asako as teaching transmitting, with speech or data, information about the location of a mobile device in response to the transmitting of speech and/or data by the mobile device is inappropriate, as Asako does not address this. Moreover, none of the other relied upon references teaches or suggests these limitations.

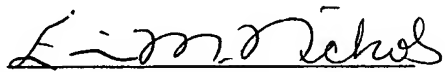
Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that each of the rejections, which are each based primarily

upon a combination of the teachings of Sandhu and Asako, is improper and without basis. It is respectfully requested that each of the pending rejections be reversed.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

Respectfully submitted,

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